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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/035,172

01/04/2002

Charles E. Hunter

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT

PAPER NUMBER

2623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/035,172	<b>Applicant(s)</b> HUNTER ET AL.	
	<b>Examiner</b> Hoang-Vu A. Nguyen-Ba	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-18 and 29-32 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/16/02, 10/4/07</u> .                                        | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to the application filed January 4, 2002.
2. Claims 19-28 have been examined. Claim 19 is an independent claim.

#### ***Priority***

3. The priority date considered for this application is September 14, 2001, which is the filing date of the provisional U.S. Patent Application No. 60/322,186.

#### ***Oath/Declaration***

4. The Office acknowledges receipt of a properly signed oath/declaration filed April 29, 2002.

#### ***Election/Restrictions***

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1-18, 29-31, drawn to a player and/or device for generating audiovisual display signals from a pre-recorded medium and a medium for storing digital data for playback, classified in class 369, subclass 219.1.
  - II. Claims 19-28, drawn to a method for displaying advertisements at a user location, classified in class 725, subclass 42.
  - III. Claim 32, drawn to a system for selectively generating display signals based on first, second third hardware security codes, classified in class 713, subclass 189.
6. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as apparatuses (I and III) and process (II) for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).

In this case, the apparatus claimed in Claims 1-18 and 29-31 can be used to display and/or store

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signals from a pre-recorded medium (e.g., optical disc such as DVD, CD), whereas the process claimed in Claims 19-28 can be used to display advertisements stored on a PVR or DVR (e.g., a hard drive) at a user location (e.g., local television or local computer system) and whereas the system claimed in Claim 32 is directed to a system to protect the reading of content stored on a device using security code (i.e., cryptography).

7. A telephone call was made to Applicant's Representative on July 23, 2008 to request an oral election to the above restriction requirement, but did not result in an election being made because Applicant's Representative was not available.

8. A restriction for examination purposes as indicated is suggested because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include an affirmation of (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) the identification of the claims encompassing the elected invention.**

9. The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be

considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be

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amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Information Disclosure Statement***

12. The Office acknowledges receipt of the Information Disclosure Statements filed September 16, 2002 and October 4, 2007. They have been placed in the application file and the information referred to therein has been considered. It should be noted that: i) all the references that do not have a publication date have not been considered; and ii) all the references that are only relevant to the provisional non-elected invention have not been considered.

### ***Drawings***

13. The drawings filed on April 26, 2002 are objected to because of the following informalities: in FIG. 3, block 316, the term "vico" is mis-typed.

### ***Specification***

14. The specification is objected to because of the following minor informalities:
- a. the filing date of the provisional U.S. Patent Application No. 60/326,563 is October 2, 2001 rather than September 28, 2001 as indicated in the specification at paragraph [002];
  - b. the assigned number of the provisional U.S. Patent Application as indicated in paragraph [003] is missing.
  - c. the filing date of the provisional U.S. Patent Application No. 60/326,563 (which is redundant since already indicated in paragraph [002]) should be October 2, 2001 rather than September 28, 2001).
  - d. "to for" at the end of line 2 of paragraph [007] appears to be a typographical error;

- e. at paragraph [057], the last sentence lacks a -- that -- or -- which -- before "may range from about 125 nm to 300 nm";
- f. The use of trademarks, such as TIVo®, Replay® at paragraph [010], DeCSS® at paragraph [012], etc. has been noted in this application. Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in a manner which might adversely affect their validity as trademarks.

To expedite correction on this matter, the examiner suggests the following guidelines for Applicant to follow in amending the specification:

- i. capitalize each letter of a trademark or accompany the trademark with an appropriate designation symbol, e.g., <sup>TM</sup> or ®, as appropriate;
- ii. use each trademark as an adjective modifying a description noun. For example, it would be appropriate to recite "the JAVA platform" or "the JAVA programming language." Note that in these examples, "platform" and "programming language" provide accompanying generic terminology, describing the context in which the trademark is used. By itself, the trademark JAVA specifies only the source of the so-labeled products, namely SUN Microsystems, Inc.

15. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

#### ***Claim Objection***

16. Claim 23 is objected to because of the following minor informalities: it is unclear as to which standard DVD specification, the "the standard DVD specification" recited at line 5 refers to.

***Claim Rejections – 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States and was published under Article 21(2) of such treaty in the English language.

It is to be understood that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art of reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant’s arguments should not be therefore considered to be that of new grounds of rejection.

18. Claims 19-21 and 24-27 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0120925 by Logan.

**Claim 19**

Logan discloses *a method for displaying advertisements at a user location, comprising:*

*generating a customer preference containing user characteristics (see at least [0007], [0009], [0011-0012], [0022], [0024], [0033], [0043-0044], [0073-0076], [0084], [0092], [0114], [0236], [0276]);*

*displaying entertainment content at the user location, the entertainment content including insertion points for display of advertisements (see at least [0009], [0012], [0093], [0096-0098], [0139-0148], [0235-0237], [0259-0260]);*



*transmitting a plurality of advertisements to the user location (see at least [0026], [0043], [0045], [0047], [0092]);*

*selecting a subset of the transmitted advertisements based upon the customer preference (see at least [0084], [0092], [0111-0113], [0226-0227], [0242], [0251-0256]);*  
*and*

*displaying at least one of the selected advertisements during at least one of the insertion points (see at least [0237], [0240], [0242]).*

#### **Claim 20**

The rejection of base claim is incorporated. Logan further discloses

*distributing a pre-recorded medium containing the entertainment content (see at least [0043], [0045], [0047], [0092]) and*

*storing the medium at the user location (see at least [0009], [0206]; FIG. 1, devices 133, 143, 147, 153, 163).*

#### **Claim 21**

The rejections of the base claim 19 and intervening claim 20 are incorporated. Logan further discloses *recording entertainment content on a medium having a hardware security feature such that display of the entertainment content is possible only upon a player device including hardware compatible with the hardware security feature (see at least [0031]).*

#### **Claim 24**

The rejection of base claim 19 is incorporated. Logan further discloses *selecting a subset of the transmitted advertisements at the user location based upon the customer preference (see at least [0084], [0092], [0111-0113], [0226-0227], [0242], [0251-0256]), and caching the subset at the user location (see at least FIG. 1, devices 133, 143, 147, 153, and 163).*

#### **Claim 25**

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The rejections of the base claim 19 and intervening claim 24 are incorporated. Logan further discloses *selecting at least one of the cached advertisements based upon the customer preference* (see at least FIG. 1, devices 133, 143, 147, 153, and 163), *and displaying the selected cached advertisements during the insertion points at the user location* (see at least [0237], [0240], [0242]).

#### **Claim 26**

The rejection of base claim 19 is incorporated. Logan further discloses *receiving the entertainment content from a source remote from the user location* (see at least FIG. 1, receiving the content from remote Broadcast Programming Source 100).

#### **Claim 27**

The rejection of base claim 19 is incorporated. Logan further discloses *wherein: selecting a subset of the transmitted advertisements based upon the customer preference comprises selecting a transmitted advertisement based on the customer preference at a plurality of user locations in accordance with a purchase transaction by an advertiser* (see at least [0235]).

### ***Claim Rejections – 35 USC § 103***

19. The following is a quotation of the 35 U.S.C. § 103(a) which form the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0120925 by Logan.

#### **Claim 22**

The rejections of the base claim 19 and intervening claims 20-21 are incorporated. Logan does not specifically disclose *wherein: the medium comprises a disk having a diameter greater than about 125 mm and less than 300 mm.*

However, official notice is taken that disc that has a diameter greater than 125 mm (i.e., 12.5 cm) and less than 300 mm (i.e., 30 cm) is the well-known laser disc that is defined as follows by Whatis.com ([http://whatis.techtarget.com/definition/0,,sid9\\_gci212454,00.html](http://whatis.techtarget.com/definition/0,,sid9_gci212454,00.html)):

#### **laserdisc**

Laserdisc is a technology and the physical medium used in storing and providing programmed access to a large database of text, pictures, and other objects, including motion video and full multimedia presentations.

The laserdisc itself is 12 inches in diameter and holds much more information than a CD-ROM disk can currently hold. Laserdiscs require relatively expensive players and are more expensive to distribute than CD-ROM disks. However, for school and corporate education purposes and any presentation requiring a great deal of motion video and the ability to create scripted or programmed access to selected portions of the laserdisc, the technology can be useful.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use disc which has a diameter (12 in or 28.48 cm) similar to that of a laser disc to store Logan's broadcast and ads contents because such a disc would allow more information to be stored.

It is noted that Applicant's specification indicates that "discs **may** provide a hardware security feature by incorporating a larger diameter than conventional CD or DVD" (emphasis added by examiner). The use of "may" is interpreted that the use of disc size (e.g., larger than 12 cm) is optional and will not be considered a distinguishable feature over the prior art (i.e., 12 cm) because the feature is optional and is not described in details in the specification how large is the diameter of the disk (e.g., a specific size range) and which type of player can read this type of disc. Without further details of the disc size and which existing player on the market that can play the disc of the disclosed size, the feature is considered to be non-enabling.

21. Claims 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0120925 by Logan in view of Tsuchiya et al. ("Tsuchiya").

#### **Claim 23**

The rejections of the base claim 19 and intervening claims 20-21 are incorporated. Logan does not specifically disclose *wherein: the medium comprises a disk having data recorded on a reflective layer and an optically transmissive coating having a total transmission at 635 nm of less than the minimum transmission set forth in the standard DVD specification.*

In an analogous art, Tsuchiya discloses a high density digital videodisc using 635 nm laser diode for the purpose of producing a high quality digital videodisc (see at least Abstract and Conclusions).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teaching of Tsuchiya in combination with that of Logan because the combination would allow more content to be stored on a high quality medium such as that taught in Tsuchiya.

Since the claim language is unclear as to which DVD Specification is being referred to and as to the meaning of “an optically transmissive coating having a total transmission at 635 nm of less than the minimum transmission set forth in the standard DVD specification,” a coating that would reflect a 635 nm laser such as the one taught in Tsuchiya is used as a basis for the rejection of Claim 23 for compact prosecution purposes. Furthermore, since Applicant’s disclosure does not specifically provide sufficient support for the claimed feature, Applicant is requested to provide the mentioned standard DVD specification and to point out where in the DVD specification is set forth the minimum transmission and how this feature is related to that of the 635 nm laser.

22. Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0120925 by Logan in view of U.S. Patent No. 5,835,896 to Fisher et al. (“Fisher”).

#### **Claim 28**

The rejection of base claim 19 is incorporated. Logan further discloses *wherein: selecting a subset of the transmitted advertisements based upon the customer preference comprises selecting a transmitted advertisement based on the customer preference at a plurality of user locations* (see at least [0084], [0092], [0111-0113], [0226-0227], [0242], [0251-0256]).

Logan does not specifically disclose that the selection is *in accordance with a winning bid of an advertiser in an auction*.

However, Fisher discloses a method for allowing a group of bidders to interactively place bids over a communications network, automatically recording the bids, updating the bidders with the current auction bid status information, closing the bidding process and notifying the winning bidder as to the auction outcome without using a human auctioneer (6:6-13).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Fisher in Logan as the use of Fishers technique would help advertisers to place bids for their advertisements and to know the outcome of the auction quickly for effective planning purposes.

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2600 Group receptionist (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/

Primary Examiner, Art Unit 2623

July 24, 2008